

## **REMARKS**

The Examiner has withdrawn his objections based on Su (US 5.462,782).

The Examiner has now raised new grounds for rejection. Referring to Wilkins (US 6038803) he rejects claims 1, 2-3, 4-8, 10, 11-12, 13, 14-15, 16-19, 24-28, 31-32, 33-40 and 41.

Referring to phrases having no patentable weight, he rejects these.

Claim 9 is said to be non-allowable, if written to depend on the rejected claim 1 but is said to be potentially allowable if standing independently.

## **APPLICANT'S RESPONSE**

Following examination of the presently-cited art and the Examiner's comments, the Applicant is clear that no-one else has thought of, experimented with and developed (ie invented) a small, readily usable cling-technology, self-adhesive mount for mounting paper and other flat sheets to glass.

Rejection and re-examination of the application have occurred, mostly due to:

- The Examiner's interpretations of cited art, vis Kassab, Su, Longtin, Shanley et al, which the Applicant has been able to refute as inapposite (and now the presently-cited art)
- the Examiner's views of the Applicant's presentation of the case.
- The Examiner's guidance of the Applicant in ensuring the correct terminology and approach.

The current distinct areas of difference between the Examiner and the Applicant are set out here, together with the Applicant's submissions on each matter and the consequences in terms of amendments to claims, and the specification and its abstract, as the Applicant has sought to meet the new comments.

Finally, the amended specification and claims are attached, together with a page summarising the status of claims following the last Office Action and in this response..

## Areas of contention

1. Differences between the Examiner and the Applicant in their understanding of a newly-cited art by Wilkins
2. The Examiner's findings that the Applicant appears to claim what is well-known in the art. The Examiner's objections are to the Applicant's use of "...a plurality of mounts..." and "...provided in the form of a roll..."
3. The Examiner's view that certain phrases, as used here, are not to be given any patentable weight. Nor are 'intended use' expressions, such as "...a mount for adhering paper to glass..." to be given patentable weight.
4. Issues with regard to the specification of certain sizes as part of the claims.
5. The Applicant is said to include claims which are "indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention"

Taking these in turn:

1. Differences between the Examiner and the Applicant in their understanding of a newly-cited art by Wilkins.

Referring to the Examiner's Action of 23<sup>rd</sup> May, he says, inter alia :-

" Wilkins also teaches a method for securing a first material to a second material comprising releasably adhering a first surface of a mount to the first material (F) which is well known to be paper in the adhesive art, with an adhesive carried by the first surface and securing the the second surface to a second material (1) without adhesive."

No. She does not.

Wilkins never mentions the use of her invented sheet for the purpose of attaching a second sheet to a third material. This, with respect, is a misinterpretation of the diagrams and a misunderstanding of the art. The Examiner has not quoted any such matter from the art in question.

Wilkins did not invent a device which carries adhesive on a first surface. She mentions adhesive only for a different reason. See below.

So, Wilkins's invention is a single flat, soft piece of opaque plastic, which exhibits "static cling" properties and may be of PVC. It has indicia on one side to replace (cover) the image already held in some glass-fronted display, to the glass of which it clings.

It adheres to no second sheet of paper or other material and mounts no second sheet to a third material, contrary to the purpose and properties of the present invention. The Applicant refers to Wilkins, Claim 7a, b, which give the essence of the Wilkins invention.

" 7 An apparatus for decorating a picture holder with a removable decorative display, comprising

- a) a first sheet of material having front and rear surfaces, said front surface of said first sheet of material having a decorative display formed thereon, at least a portion of said front surface being opaque;
- b) said first sheet of material being formed from a plastic material exhibiting static cling thereby permitting the first sheet of material to be removably adhered to a portion of the picture holder..."

Nowhere in Wilkins is there any indication of an adhesive being pre-coated on the indicia-bearing decorative covering – not even as a means of adhering the protective backing sheet to the invented sheet, for which she stipulates:- "...the protective backing F may be formed from any material which can be electrostatically adhered to the decorative covering E ".

The Wilkins statement following on from this sentence (above) refers, not to any adhesive being pre-coated to the invented sheet for the purpose of adhering a second sheet to a third material but to the optional use of a tacky adhesive to stick that very invented sheet to the glass covering the original picture – a statement which, incidentally, surely negates the premise of Wilkins invention, which is that the decorative cover should adhere itself to the original picture's glass facing by cling.

Otherwise, there is no need for the use of a soft "cling" plastic and one might as well stick a paper picture over the original picture's glass facia.

The Wilkins statement referred to – and the only mention of adhesive by Wilkins, is :- "Optionally, a tacky adhesive may be used to secure the decorative covering D to the original picture B"

Wilkins has in fact succeeded in patenting the idea of cutting out a picture and sticking it over another, sometimes using adhesive, most times using cling properties.

The Applicant respectfully contends that neither this occasional use of adhesive, nor any other aspect of Wilkins, has any bearing on the present application, in which a soft mount, exhibiting cling properties, and which is pre-coated with adhesive on one side, is adhered thereby to a second sheet – normally of paper – and is then

used to hold that paper against glass by the cling properties of its uncoated side being developed in all respect - size, material and delivery - to fulfil this role.

The present mount is used as a tool, an intermediary, to mount to glass a sheet, usually of paper, which would otherwise not adhere to the glass. The present application relates to a novel and unobvious device for attaching paper to glass. The Applicant therefore respectfully requests that the Examiner withdraw his objections given with reference to Wilkins.

The Applicant has made no amendments consequent on Wilkins

2. The Examiner's findings that the Applicant appears to claim what is well-known in the art. The Examiner's objections are to the Applicant's use of "...a plurality of mounts.." and "...provided in the form of a roll.."

The exact objections are :-

**A)**

That the Applicant, in two qualifying claims dependent on claim 1, namely claims 2 and 3, in seeking to show that the mount or mounts may be produced either on a roll or on sheets of backing material, appears to claim what would be obvious to anyone versed in the relevant art.

That it would be obvious to anyone versed in the art is of course clear. However, the intention was not to claim the actual art of producing the mounts in this form but to expand on the main claim, 1 and qualify the manifestation of the invention.

The Applicant notes that, in art previously cited in this application , Longtin (US 5,334,431) used exactly the same approach, namely :

"Claim 2 An assembly as in claim 1, wherein said continuous web is a roll" It is therefore by no means clear why it is not acceptable for the Applicant to make a similar statement.

**Action**

In order to progress, the Applicant has chosen to cancel the two relevant claims.

**B)**

In a similar vein, the Examiner objects to the use of the expression " a plurality of mounts" appearing as part of claims, including claim 1.

The Examiner quotes *St Regis Paper v Bemis Co.*, 193 USPQ 8 in support of this and notes, "...since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art."

The Applicant acknowledges the point made but is confused to find, again in Longtin (5,334,431) the evident acceptance of the phrase, in his claim 1,

" 1. An assembly comprising .....a plurality of individual release liners releasably adhered to said continuous web"

This is not describing the complex nature of each single release set-up but is referring to the existence of many such, along the web.

Longtin, could therefore have described and claimed his invention based on one example of the "piggy-back" assembly of labels, describing a single release liner, as the Examiner would have the Applicant do.

Instead, Longtin has made the point that his invention manifests itself on a roll and that on that roll, there is claimed a plurality of release liners.

The Applicant fails to comprehend the difference in the language or concept between Longtin and the present application in this respect, Longtin having been granted.

Lastly, elsewhere in the specification and claims of the present application, it is made clear that the evaluation and selection of specific sizes for the invented mount is predicated on the fact that a plurality of the said mounts is generally required to be used at any one time in order successfully to mount paper.

### **Action**

Notwithstanding this, the Applicant has chosen to remove reference to the term "plurality" from his application's claims and to substitute "a mount", or "a mount or mounts" and hopes that this will find acceptance and is not deemed to change the nature of the claims.

3. The Examiner's view that certain phrases, as used here, are not to be given any patentable weight. Nor are 'intended use' expressions, such as "...a mount for adhering paper to glass.." to be given patentable weight.

The Applicant understands that the expression "not given any patentable weight" implies that, were the acceptance of the claim in which it appeared to rely on a particular statement alone, such as "...for mounting a sheet object..", it would not suffice to make acceptable that claim. It is understood, however, that it is acceptable to retain the expression to give assistance in defining the area or sector to which the invention applies.

The Examiner has objected, specifically, to the use of the expression "capable of" and to the intended use phrase " ..for mounting paper to glass..".

In the case of the expression, "capable of", the applicant had previously accepted this but had failed to rid the claims completely of the phrase. The present action is to remove this phrase and the Applicant thanks the Examiner for drawing this to his attention.

However, in the case of the expression "...for mounting paper to glass", the applicant finds that his use of such a phrase is directly similar to the use of the phrase " ..for mounting a sheet object..." by Su, in his claim 1 (and all others) of a granted patent, (US 5,462,782), an art cited previously by the examiner and for which the Examiner was the Primary Examiner.

### **Action**

The Applicant has retained the intention of the phrase "...for mounting paper to glass.." but generally re-phrased this as "...for mounting a sheet object to glass.."

Similarly, the Applicant has retained the phrase " which adheres the mount to only part ... mountable arrangement"

In both cases, the Applicant has sought to ensure that no claim stands upon the weight of these phrases alone.

#### 4. Issues with regard to the specification of certain sizes as part of the claims.

The Examiner introduces the issue of the size ranges specified for the invented mounts, by referring to Wilkins.

Notwithstanding that the Applicant hopes to have persuaded the Examiner to withdraw Wilkins as irrelevant, this issue is addressed here.

The Examiner has decided that the preferred sized arrived at by the Applicant would have been obvious to Wilkins or anyone following the art. He further states that the expression used to describe the size of the present mount :-

" .. which adheres the mount to only a part of one surface of the sheet of paper..." does not have patentable weight. This expression, however, is used to distinguish between the present application and previously-cited art:-

An essential difference between the several arts cited by the Examiner and the present application, is that the sizes of the mounts in the present application are the deliberate result of experimentation to optimise the dimensions and other properties of the mount in question. The size is part of the idea.

Several previously cited arts taught of sheets which adhered to other sheets such as paper – and which usually adhered to glass by cling – but all were of at least the same size as the paper of other sheet which was adhered to them.

In developing such a mount as is the present application, the optimum balance was achieved between, on the one hand, the provision of large enough surfaces to adhere to the paper and then to adhere to the glass while carrying the paper sheet, and, on the other hand, the creation of a small, easily-used and unobtrusive device. This produced a fairly tight range of sizes, as described in the application, which, broadly, are those of a "small", "thin" mount.

By "Small" is meant that the mount ( optimised at 100 mm<sup>2</sup> – 900mm<sup>2</sup> and up to 2mm thick) is deliberately intended to fit into the corners of a sheet of paper which it is then intended to adhere to glass using several of these mounts. This, incidentally, is why the term "plurality" was used in this application. Not because the Applicant wished to claim the techniques for making a multiple item but to indicate that the intended use is, generally, of multiple mounts per sheet object. The discovery was that the holding performance of such small tags in sheer was sufficient to permit the specification of sizes which a) were so small as to be inconspicuous in performing the task and, b) a multiplicity of mounts would be used per application.

Even the upper size mentioned here is scarcely 1% of the area of, say, an A4 sheet of office paper. Therefore, to draw distinction between the mount and other devices, the sizes of the device are given and claimed (because they are the result of a period of

empirical work – conducted in isolation from other art such as Wilkins, which is irrelevant in that it does not start out to do remotely the same thing. With respect to sizes, there was no prior art. The inventor set out to balance properties such as resistance to peel (due to paper sheets distorting once mounted), sheer-strength of the bond, convenience and manageability of the tag in an environment in which there were (are) no comparable concepts ) The sizes are part of the intellectual property therefore and further emphasis is lent by including a claim that shows that the mount is designed to attach to a part, only, of the sheet, thus further defining the invention.

In the opinion of the applicant, this size-indicating phrase

" the first surface of each mount adheres the mount to only a part of the sheet of paper.."

is as definite as, has the same weight as, the use, by Wilkins, (6,038.803) of: Claim 11, a) "said sheet of material is sufficiently sized to overlie completely an original picture of a picture holder".

The applicant hopes that the matter of optimum sizes is presented clearly in the Specification.

#### **Action**

The Applicant wishes the claims relating to size to remain and requests the Examiner to further consider their acceptability in the light of the fact that it is established that there was no direct prior art from which to develop the invention.



5. The Applicant is said to include claims which are "indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention"

The Examiner refers in particular, to claims 10 – 12, which he rejects under 35 USC 112 as indefinite.

The Applicant thanks the Examiner for drawing this to his attention.

#### **Action**

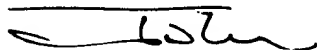
The Applicant has decided to cancel these claims and to review carefully others which may now also be redundant

#### **Conclusion**

The applicant hopes that the present submission is procedurally acceptable and respectfully asks that the examiner withdraw his remaining objections to the patentability of the present application.

Should the examiner feel that a 'phone interview would be helpful, he is respectfully requested to contact the applicant, John MacAlister, on +44 1728 668 204, at any time, notwithstanding the time-zone differences, or to fax + 44 1728 668 664, giving a convenient time for the applicant to call back.

Submitted by



John MacAlister  
July 21st, 2005

## Application 09/905,261 : Status of claims July 2005

No.	STATUS	Reason for status	Action taken by Applicant
	at 05 23 05		Jul-05
1	Rejected	Unpatentable over Wilkins?	Ammended
2	Rejected	Unpatentable over Wilkins? re Walker	Cancelled
3	Rejected		Cancelled
4	Rejected	Unpatentable over Wilkins?	Ammended
5	Rejected	↓	Ammended
6	Rejected		Ammended
7	Rejected		Ammended
8	Rejected		Ammended
9	<b>Objected to</b>	"Could be accepted if rewritten"	Ammended
10	Rejected	"Indefinite" "unpatentable over Wilkins"	Cancelled
11	Rejected	Unpatentable over Wilkins?	Cancelled
12	Rejected	Unpatentable over Wilkins?	Cancelled
13	Rejected	Unpatentable over Wilkins?	Cancelled
14	Rejected	Unpatentable over Wilkins?	Ammended
15	Rejected		Ammended
16	Rejected	Unpatentable over Wilkins?	Ammended
17	Rejected	Unpatentable over Wilkins?	Ammended
18	Rejected	Unpatentable over Wilkins?	Ammended
19	Rejected		Cancelled
20	Cancelled		Cancelled
21	Cancelled		Cancelled
22	Cancelled		Cancelled
23	Cancelled		Cancelled
24	Rejected	Anticipated by Wilkins?	Cancelled
25	Rejected		Ammended
26	Rejected		Ammended
27	Rejected		Original
28	Rejected		Original
29	Cancelled		Cancelled
30	Cancelled		Cancelled
31	Rejected	Unpatentable over Wilkins?	Original
32	Rejected		Original
33			Ammended
34			Original
35			Ammended
36			Previously amended
37			Previously amended
38			Previously amended
39			Previously amended
40			Previously amended
41	Rejected	Unpatentable over Wilkins?	Ammended